

CONSIDERED: /W.J./

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|             |                   |   |                   |                  |
|-------------|-------------------|---|-------------------|------------------|
| APPELLANT:  | Klaus Biester     | § | ART UNIT:         | 3656             |
|             |                   | § |                   |                  |
| SERIAL NO.: | 10/525,937        | § | EXAMINER:         | William C. Joyce |
|             |                   | § |                   |                  |
| FILED:      | February 25, 2005 | § | CONFIRMATION NO.: | 4987             |
|             |                   | § |                   |                  |
| FOR:        | Drive Device      | § | ATTY. DKT. NO.:   | 1600-11800       |
|             |                   | § |                   |                  |

REPLY BRIEF

**Mail Stop Appeal Brief – Patents**  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Date: May 28, 2010

Sir:

In response to the Examiner's Answer dated March 29, 2010, Appellant submits this Reply Brief for further consideration by the Board. Appellant will not repeat the arguments from his main Brief, and instead addresses a few select arguments made by the Examiner in the Answer.

**I. CLAIMS REJECTED AS ANTICIPATED BY LINZENKIRC**

Claims 1, 2, 14-16, and 19 stand rejected as anticipated by Linzenkirc. In order to establish a *prima facie* case of anticipation, the Examiner must show that each and every element of the claims is disclosed, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). If a single element is not found in the prior art reference, the claims are not anticipated. Additionally, the Federal Circuit has held that "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference ***arranged as in the claim.***" *Brown v. 3M*, 265 F.3d 1349, 60 U.S.P.Q.2d 1375 (Fed. Cir. 2001). Thus, an invention is anticipated only when the ***same device*** having all the elements contained in the claim limitations, is described in a single prior art reference.

In the Examiner's Answer, the Examiner states, in reference to the Final Office Action dated March 12, 2010, that he "clearly indicated the claimed features of the device by way of reference numbers." Examiner's Answer, page 5. Indeed, the Examiner has done so, but for only some and not for all of the elements recited by the rejected claims.

Referring to the Final Office Action, the Examiner identified components of Linzenkirc having reference numbers (9, 9'), (10, 10'), (11, 11'), and (12) as disclosing the claimed driving motor, drive train, drive shafts, and wheel-shaped revolution introducing device, respectively. Final Office Action, page 2. The Examiner did not, however, indicate by reference number, or other manner, which portions of Linzenkirc he finds disclose the claimed transmission changing unit, revolution/linear motion converter, and operating element. Furthermore, he did not do so in the Office Action dated September 15, 2008. The Examiner's Answer offers no clarification. In the Answer, the Examiner simply copied verbatim a sentence from the Linzenkirc Abstract, but did not go the extra step by identifying which of the components and associated reference characters included in the sentence he finds disclose the claimed transmission changing unit, revolution/linear motion converter, and operating element. Examiner's Answer, page 5.

For these reasons, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of anticipation of claims 1, 2, 14-16, and 19 by Linzenkirc.

## **II. LINZENKIRC**

In the Examiner's Answer, the Examiner notes that the Appellant has not filed a petition to have the Examiner obtain and supply a translation of Linzenkirc and that nonetheless, an English translation of Linzenkirc was filed on December 12, 2009. Examiner's Answer, page 5.

To date, the Examiner has not made it clear whether his claim rejections are based solely on the Abstract of Linzenkirc or on the full text of Linzenkirc. If the former, Appellant has no need for a full translation of this reference and a petition for such is unnecessary. If the latter, Appellant notes that the date identified by the Examiner as the date on which Linzenkirc was filed is six months after issuance of the Final Office Action and four months after filing of the Appeal Brief. In fact, Appellant was put on notice that a translation of Linzenkirc had been obtained by way of the 2<sup>nd</sup> Notification of Non-Compliant Appeal Brief issued on December 7, 2009. That Linzenkirc was filed on December 12, 2009 and made available sometime afterward was of no use to the Appellant during prosecution, whether the Examiner relied on it or not.

Because the Examiner did not make available a full translation of Linzenkirc during prosecution, Appellant has assumed and continues to assume that the Examiner has relied only on the Abstract and Figures of Linzenkirc to support the claim rejections. Appellant respectfully submits that the Abstract and Figures of Linzenkirc do not disclose all of the elements recited by claims 1, 2, 14-16,

and 19. In particular, these documents do not disclose the claimed transmission changing unit and revolution/linear motion converter.

### **III. INTERNATIONAL SEARCH REPORT OF LINZENKIRC**

To add further confusion, the Examiner states in his Answer that "the combination of the English Abstract, the Figures, and the International Search Report of Linzenkirc clearly teach each and every component of the claimed device." Examiner's Answer, page 5. This statement suggests that the Examiner has relied in some way on the International Search Report to support a claim rejection. The Examiner did not indicate a reliance on the Search Report to support any of the claim rejections during prosecution. Thus, the above-quoted statement also suggests that the Examiner may be attempting to raise a new ground of rejection in the Answer. However, the Examiner has not identified a new ground of rejection in Section 6 of the Answer, entitled "Grounds of Rejection to be Reviewed on Appeal," or Section 9, entitled "Grounds of Rejection," as required by M.P.E.P. 1207.03 when raising a new ground of rejection in the Answer. Consequently, Appellant believes the Examiner's reference to the International Search Report is not intended to be a new ground of rejection.

### **IV. CONCLUSION**

For the reasons stated above as well as in Appellant's principle brief, Appellant respectfully submits that the Examiner erred in rejecting all pending claims. It is believed that no extensions of time or fees are required. However, in the event that an extensions of time is necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(b), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 03-0335 of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,

/Carol E. Smith/  
Carol E. Smith, Ph.D., P.E.  
Reg. No. 66,084  
CONLEY ROSE, P.C.  
P.O. Box 3267  
Houston, Texas 77253-3267  
(713) 238-8000 (Tel.)  
(713) 238-8008 (Fax)

CAMERON INTERNATIONAL CORPORATION  
P. O. Box 1212  
Houston, Texas 77251